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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,013

09/27/2004

Yoshio Yoshida

TAKIT-0191

1252

23599 7590 09/05/2007  
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
2200 CLARENDON BLVD.  
SUITE 1400  
ARLINGTON, VA 22201

EXAMINER

HIGGINS, GERARD T

ART UNIT

PAPER NUMBER

1709

MAIL DATE

DELIVERY MODE

09/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/509,013		YOSHIDA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Gerard T. Higgins		1709	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/09/2005</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining

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compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, the phrase "type" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(b) and *Ex parte Attig*, 7 USPQ2d 1092 (Bd. Pat. App. & Inter. 1986).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (US 2001/0016249) in view of Hiromine (JP 2002-011936).

Kitamura et al. teach an "ink jet recording medium...at least one ink receiving layer of the image-recording stratum further comprises...the binder and the fine pigment particle of at least one pigment selected from the group consisting of... $\gamma$ -aluminas and having an average particle size of 1  $\mu\text{m}$ " [0164]. The particle size distribution mentioned by applicants in their claim 6 directly influences the amount of gloss and ink uptake of the recording media, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the particle size distribution to arrive at the proper particle size distribution to lead to the desired gloss and ink uptake for the resulting product. Kitamura et al. further teach that the support may be made of "wood pulp include[ing] mechanical pulps, chemical pulps, and re-used paper pulps" [0131]. In light of applicants' specification (page 4, lines 21-25), these are perfectly appropriate supports for the recording layer. Kitamura et al. also teach the "binder preferably comprises at least one member selected from the group consisting of...water-dispersible polyurethane resins" [0178]. Furthermore, they teach the "binder preferably comprises at least one member selected from the group consisting of polyvinyl alcohol"

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[0179]. However, Kitamura et al. does not teach using a cationic polyester/polyurethane resin in the binder layer, nor does it teach the cationic degree of the urethane resin, a glass transition temperature of 10-50°C, and image clarity of 20% or greater, or a contact angle of 50° or less relative to water. Hiromine teaches a "cation mold polyurethane resin of an ester system," which has "40 degrees C or less of [a] glass transition temperature" [0013]. This reads on limitations presented in applicants' claims 1 and 4.

Furthermore, it is well known in the art to manufacture inkjet recording media having, for example, acceptable brightness, whiteness, opacity, holdout, and an appropriate finish. In regards to claims 2 and 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the cationic degree of the cationic polyester/polyurethane resin to achieve a recording medium having the appropriate contact angle with respect to water. This would allow the inkjet ink to bead properly and result in an image that possessed the proper image clarity according to applicants. It is also well known to anyone within the art to treat inkjet recording media in such a way as to arrive at the appropriate amount of gloss needed for the desired product. Finally, the process of pressing a wet inkjet recording media against a heated drum and drying it to arrive at a surface with high gloss is also well known to someone having ordinary skill in the art and therefore renders applicants' claim 7 obvious to one having ordinary skill in the art.

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**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerard T. Higgins whose telephone number is 571-270-3467. The examiner can normally be reached on M-F 7:30am-5pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**D. LAWRENCE TARAZANO**  
**PRIMARY EXAMINER**  


Gerard T Higgins  
Examiner  
Art Unit 1709

